

USSN: 09/893,223Attorney Docket No.: 117-P-1062USD1**Remarks**

Applicants have editorially amended the written description and Drawing. Support for the recitation of a "floor tile 11a" can be found at, e.g., page 14, lines 13 – 14 and in Fig. 1. Support for recitation of a "Tile core 78" can be found at, e.g., page 49, line 18, page 50, line 14, page 51, lines 9 – 18 and in original claim 43. Support for the recitation that tile core 78 "lies under surface 77" can be found in, e.g., original Fig. 6 and original claim 43. Support for the recitation that "After treatment with the restoration process the elemental composition of surface 77 is substantially the same as the elemental composition of core 78" can be found at, e.g., page 51, lines 4 – 10 and in original claim 43. Following entry of this amendment, claims 38 – 42 and 45 – 47 will be pending in this application.

**35 USC §132 Objection**

The amendment filed November 3, 2003 was objected to grounds that it introduced new matter into the disclosure, due to the addition of reference number 78 to Fig. 6. The Office Action correctly pointed out that reference number 78 was not identified in the written description. This has been corrected by the present amendment, and should overcome this objection.

The Office Action stated that:

*"the specification does not provide any teaching or discussion in how an underlying core is used in conjunction with a floor traffic surface, or structured as an underlying core adjacent to the flooring surface, or how to make the underlying core or multilayered structure."*

By way of explanation, the core and its relation to the traffic surface are described at e.g., page 49, line 18, page 50, line 14, page 51, lines 9 – 18 and in original claim 43. The traffic surface is described in the same passages and elsewhere throughout the written description (see e.g., page 3, line 4 through page 5, line 4). The recited surface and core are also shown in, e.g., original Fig. 6. Applicants should not be required to describe "how to make the underlying core" – that is the province of a quarry tile manufacturer. Applicants describe a cleaning or restoring process that removes a portion of the tile surface and provides a treated tile whose traffic surface has an elemental composition that is substantially the same as the

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elemental composition of the tile core. Further details can be found at, e.g., page 49, line 10 through page 51, line 18.

The Office Action also stated that:

*"Essentially, the original specification is absent to any teaching of how a flooring surface and underlying core are laminated together, if that is Applicant's intent for the additional new modifications."*

Applicants are not describing a lamination process. Applicants describe a cleaning or restoration process that removes a portion of the tile surface.

Applicants accordingly request withdrawal of the 35 USC §132 objection.

#### **35 USC §112, First Paragraph Rejection**

Claims 45 – 47 and 38 – 42 were rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully disagree. Rejected claims 46 – 47 and 38 – 42 all depend directly or indirectly from rejected claim 45, which recites "A tile floor comprising tiles having a floor traffic surface and an underlying core, wherein the floor traffic surface is slip-resistant, has microscopic peaks and valleys, and has an elemental composition substantially the same as that of the underlying core." This claim is supported by at least the passages indicated in the preceding two paragraphs, and does not require further support for the reasons already indicated.

Applicants accordingly request withdrawal of the 35 USC §112, first paragraph rejection of claims 45 – 47 and 38 – 42.

#### **Drawing Objection**

The objection to the drawing has been addressed as noted above.

#### **35 USC §103 Rejection**

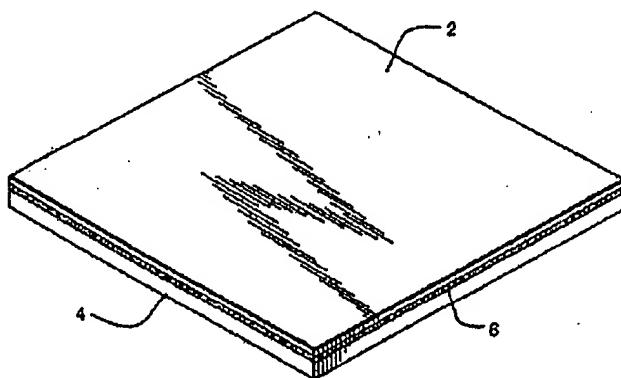
Claims 38 – 42 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,314,554 (Owens). The Office Action asserts that:

*"Owens further provides an underlying core, 4 in Figure 2 of various types of quarry tile compositions at col. 7, lines 10-45 and of ceramic. The tile*

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*configuration and structure includes an underlying region of the same material-quarry, which is on an upper region/surface also. Additionally, there are subsequent layers, more than one, which may be applied to the substrate of natural stone material, thereby providing a laminate structure. While Owens does not state in the same words, e.g. a same material used in the underlying core and upper layers, the upper layers are still of the same material, because the entire tile material is made of quarry, which includes an underlying region of quarry and an upper surface of quarry elemental composition. It would have been obvious to one of ordinary skill in the art to modify to include the underlying core as a separate layer of the same material as a surface layer because extra layers like stone and marble are multilayers that are laminated see col. 4, lines 20-30. It would have been obvious to one of ordinary skill in the art to modify an underlying core and upper layer of similar material because Owens provides additional layers of similar composition may be laminated to provide a multilayered tile structure."*

Applicants respectfully disagree. Owens does not provide a tile with the "same material used in the underlying core and upper layers". Owens uses two different materials, namely a layer of natural stone 2 and a substrate 4 said to be "best described as a ceramic subsurfacing unit" (see e.g., col. 6, lines 4 – 6 and 51 – 65 and Fig. 2):

**FIG. 2**

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Owens uses two different materials for deliberate reasons, explained at, e.g., col. 4, lines 8 – 14:

*"The present invention provides a tile product having an upper laminate of natural stone and a lower laminate of ceramic tile, the appearance of which is equivalent to solid natural stone tile, but which is lighter in weight and higher in strength than natural stone and which is stable in moist environments, i.e., is moisture-impervious."*

Owens' stated goals, namely a tile product having the appearance of solid natural stone but having lighter weight and higher strength, would not be met by using the same material in both Owens' underlying core and upper layers. An Office Action should not make out a *prima facie* case of obviousness based on a proposed modification that would render the prior art unsatisfactory for its intended purpose or change its principle of operation, see MPEP §2143.01. Applicants accordingly request withdrawal of the 35 USC §103(a) rejection of claims 38 – 42 and 45 over Owens.

### Conclusion

No new matter has been introduced into the application. No proper basis has been set forth for modifying Owens to provide a tile floor comprising tiles like those recited in claim 45. Applicants request withdrawal of the rejections and passage of their application to the Issue Branch.

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Respectfully submitted on behalf of  
Ecolab Inc.,



David R. Cleveland  
Registration No: 29,524  
612-331-7412 (telephone)  
612-331-7401 (facsimile)

USPTO Customer No.  
23322

IPLM Group, P.A.  
P.O. Box 18455  
Minneapolis, MN 55418